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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,806	11/18/2003	Steven E. Lentsch	163.1320USC1	6770
7590 08/11/2004			EXAMINER	
Attn: Dennis R. Daley MERCHANT & GOULD P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			HARDEE, JOHN R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,806

Applicant(s)

LENTSCH ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-46 is/are pending in the application.
- 4a) Of the above claim(s) 44-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 27-37 and 39-43 is/are rejected.
- 7) ☒ Claim(s) 38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 022004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restriction

1. The restriction requirement between composition and method is withdrawn. The examiner apologizes for any confusion resulting from its issuance.
2. Applicant appears to have mistaken the second restriction requirement for an election of species. This restriction was made on the grounds that the named species are capable of supporting separate patents. If applicant does not believe this to be the case, applicant should state on the record that the enumerated species are obvious variants, and this restriction requirement will be withdrawn. As a courtesy to applicant, this restriction is not being made final as applicant has not yet taken the opportunity to traverse it.

Claims 44-46 are withdrawn from consideration by the examiner as being drawn to non-elected inventions. The remaining claims were examined only to the extent that they read on the elected block copolymers.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27, 30-32 and 34-39 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8, 10 and 12-14 of U.S. Patent No. 6,673,760 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a rinse agent composition comprising the elected sheeting agent and a polybetaine siloxane in the same ratio as presently claimed. Claim 8 discloses the addition of glycerol, and claims 12-14 further narrow the ratio of sheeting agent to humectant as seen in the present dependent claims. This reference differs from the claimed subject matter in that it does not claim a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference claims all of the ingredients recited by applicants in the same ratios. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27, 31, 35 and 39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fox et al., US 4,260,528. See Example 14, which contains 10% of polyoxyethylene-polyoxypropylene block copolymer and 10% of glycerol. The polymer is called "polyoxymethylene-polyoxypropylene" but this is clearly a typo. See other examples, as well as col. 3, lines 33-34 and 45-47.

6. Claims 27-31, 35 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Man, US 5,501,815. Table 4 discloses a number of compositions consisting of 1:1 mixtures of alkyl polyglycoside and EO-PO block copolymers. See also col. 9, line 56, which discloses a more preferable APG: block ratio in a formulated rinse aid of about 1:3 to about 1:1. A teaching that this range is preferable anticipates the claims as well. Addition of citric acid to raise pH is disclosed in the examples.

Claim Rejections - 35 USC § 103

7. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly

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owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 27, 30-33, 35-37, 39, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welch et al., US 5,516,452. The reference describes aqueous rinse aid compositions for kitchen utensils containing a blend of two nonionic surfactants (abstract). The first of these surfactants is an alcohol alkoxyate with an R group of 6-18 carbons, at least three equivalents of ethoxylation and at least two equivalents of propoxylation or butoxylation (col. 2, lines 13+). The second surfactant is a block copolymer of ethylene oxide and propylene oxide with a molecular weight of about 2,000-5,000. These surfactants are preferably present at a ratio of about 4:1 (col. 4, lines 20-21), in a combined concentration, in a particularly preferred embodiment of about 20% by weight (col. 4, lines 36-39). In this preferred embodiment then, the block copolymer is preferably present at a concentration of about 4%. Auxiliary components, such as propylene glycol, may be present at up to 10% of the compositions. Being aqueous, the compositions comprise water. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that the block copolymer recited by applicants and propylene glycol, are suitable for inclusion in a surfactant composition at a ratio of about 4:10. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257,

191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

10. Claims 27-31, 33-35 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum, US 5,589,099. The reference discloses low foaming rinse aids comprising an ethylene oxide-propylene block copolymer. The polymer preferably has a molecular weight above 5,000 (col. 4, lines 9-11). Note Table I, in which the nonionic is most preferably present at 10-30% of the composition, and preservative is most preferably present at 0.025-0.2%. In this most preferred embodiment, diluents comprise about 54% by weight of the composition. The diluent is preferably water or water in combination with a compatible solvent. Among the disclosed compatible solvents are propylene glycol and glycerine. Citric acid is a preferred preservative. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition in amounts which read on those recited by applicants. The examiner takes the position that the reference fairly discloses, albeit indirectly, amounts of propylene glycol and glycerol which would read on the ratios recited in the claims. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

11. Claims 27-31, 33-35 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lentsch et al., US 5,880,089. At col. 7, lines 59+, the reference discloses a preferred rinse aid composition comprising 5-40% by weight of a nonionic block copolymer of ethylene oxide and propylene oxide and about 0.1-10% by weight of the polybetaine polysiloxane depicted at the top of col. 8. Compositions may contain diluents such as water, propylene glycol and glycerine (col. 10, lines 12+). Citric acid may be added (col. 10, line 59). This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

12. Claims 27-31, 35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Man, US 5,501,815. See the 102 rejection above. The claims are obvious because they are anticipated.

13. Claims 27, 30, 31, 33-35, 39, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al., US 4,260,528. The reference discloses aqueous high viscosity liquid dishwasher compositions which contain a surfactant, which is

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preferably polyoxyethylene-polyoxypropylene block copolymers (col. 3, lines 45-47) with a MW of about 1500-3000 and about 0.3% to about 10% of a polyhydric alcohol, which may be glycerol or propylene glycol (col. 4, lines 56+). See also claims 1, 3, 4, 7 and 8. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

Allowable Subject Matter

14. Claim 38 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

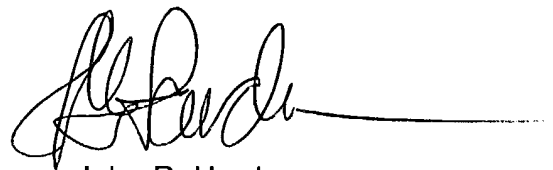
15. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record is the references relied upon above. They do not disclose or motivate the use of the surfactant disclosed in this claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'John R. Hardee', with a long horizontal line extending to the right.

John R. Hardee
Primary Examiner
August 6, 2004